

Inventive Step following Conor

UK High Court confirms the House of Lords was "spot-on" on obviousness

In recent years, the UK courts have noticeably changed their approach to patentability, aligning them more closely with the approach of the European Patent Office (EPO). The turning point in assessing obviousness was the House of Lords decision in *Conor v Angiotech*, in which Forresters successfully represented the defendants. The England and Wales High Court continues to follow the House of Lords' approach.

The Case

Omnipharm Limited v Merial was a dispute over the inventive step of two of Merial's patents, relating to an anti-flea treatment for pets. The core concept of each patent was the use of fipronil in a "spot-on" formulation. Spot-on formulations are applied - as the name suggests - to a "spot", usually between the shoulder blades of the animal. From that location certain compounds can work systemically, although it was unclear how.

The Decision

The worker in the field knew that fipronil had anti-flea activity. Onmipharm argued that they would consider it obvious to try the compound in a "spot-on" formulation.

The judge reviewed the recent law, particularly *Conor v Angiotech*, and concluded that "obvious to try" was not sufficient to prove obviousness. He held that, for the claim to be obvious, the skilled person must have had a fair expectation that the formula would be effective. This approach mirrors that of the EPO, which requires a "reasonable expectation of success" to find obviousness.

The judge agreed that it would be obvious to try to develop a fipronil spot-on formulation. However, because the field had no generally accepted theory of such "spot-ons" work, the skilled person would not have sufficient expectation that it would work.

The judge found the patents to be inventive.

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This decision is a clear indication that the UK courts continue to move closer to the EPO approach to inventive step, as do other European courts. This is an encouraging sign of increasing harmonisation amongst European Courts, which we hope will lead to greater certainty for all parties in future patent disputes.